Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HENRY NICPONSKI

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Appeal No. 95-4390
Application 08/066,273[1]

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ON BRIEF

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Before HAIRSTON, JERRY SMITH and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed May 24, 1993.

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This is a decision on the appeal under 35 U.S.C. § 134

from the examiner's rejection of claims 7-12, which constitute

all the claims remaining in the application.

The disclosed invention pertains to a method and

apparatus for modifying electronic image data. Specifically,

original image data is displayed to an operator. The operator

enters information defining an optical axis, a projection

point, a density contour shape and a density gradient profile.

A processing means responds to this data to replace the

original image by an enhanced image.

Representative claim 7 is reproduced as follows:

7. An apparatus for modifying electronic image data
comprising:

scanning means for generating original image data
representative of an original image;

display means for receiving the original image data
and displaying the original image;

data entry means for identifying a portion of the
original image displayed on the display means to be modified,
and for defining an optical axis, a projection point, a
density contour shape and a density gradient profile within
the identified portion of the original image;

processing means for calculating modified image data
for the identified portion based on the defined optical axis,
projection point, density contour shape and density gradient,
and for replacing a portion of the original image data

representative of the identified portion of the original image
with the modified image data to generate enhanced image data
representative of an enhanced image; and

recording means for receiving the enhanced image data
from the processing means and producing a hard copy of the
enhanced image.

The examiner relies on the following reference:

Obata et al. (Obata)   5,083,287   Jan. 21, 1992

Claims 7-12 stand rejected under 35 U.S.C. § 103. As

evidence of obviousness the examiner offers Obata taken alone.

The final rejection of claims 7-12 under 35 U.S.C. § 101 was

withdrawn by the examiner [answer, page 2].

Rather than repeat the arguments of appellant or the

examiner, we make reference to the brief and the answer for

the respective details thereof.

<div align="center">OPINION</div>

We have carefully considered the subject matter on

appeal, the rejection advanced by the examiner and the

evidence of obviousness relied upon by the examiner as support

for the rejection. We have, likewise, reviewed and taken into

consideration, in reaching our decision, the appellant's

arguments set forth in the brief along with the examiner's

rationale in support of the rejection and arguments in

rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record

before us, that the teachings of Obata and the level of skill

in the particular art would have suggested to one of ordinary

skill in the art the obviousness of the invention as set forth

in claims 7-11. We reach the opposite conclusion with respect

to claim 12. Accordingly, we affirm-in-part.

Appellant has indicated that for purposes of this

appeal the claims will stand or fall together in the following

two groups: Group I has claims 7-11 and Group II has claim 12.

Consistent with this indication appellant has made no separate

arguments with respect to any of the other claims on appeal.

Accordingly, all the claims within each group will stand or

fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ

136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991,

217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only

consider the rejection against claims 7 and 12 as

representative of all the claims on appeal.

As a general proposition in an appeal involving a

rejection under 35 U.S.C. § 103, an examiner is under a burden

to make out a <u>prima facie</u> case of obviousness. If that burden
is met, the burden of going forward then shifts to the
applicant to overcome the <u>prima facie</u> case with argument
and/or evidence. Obviousness is then determined on the basis
of the evidence as a whole and the relative persuasiveness of
the arguments. <u>See</u> <u>In re Oetiker</u>, 977 F.2d 1443, 1445, 24
USPQ2d 1443, 1444 (Fed. Cir. 1992); <u>In re Hedges</u>, 783 F.2d
1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); <u>In re</u>
<u>Piasecki</u>, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.
1984); and <u>In re Rinehart</u>, 531 F.2d 1048, 1052, 189 USPQ 143,
147 (CCPA 1976).

Appellant's initial argument is that the examiner has
failed to make out a <u>prima facie</u> case of obviousness.
Appellant should not confuse the <u>prima facie</u> case with the
ultimate determination of the relative persuasiveness of the
substantive arguments in support of the rejection. In order
to satisfy the burden of presenting a <u>prima facie</u> case of
obviousness, the examiner need only identify the teachings of
the references, identify the differences between the prior art
and the <u>claimed</u> invention, and provide a reasonable analysis
of the obviousness of the differences which an artisan might

find convincing in the absence of rebuttal evidence or

arguments.

With respect to the appealed claims, the examiner has

pointed out the teachings of Obata, has pointed out the

perceived differences between Obata and the claimed invention,

and has reasonably indicated how and why Obata would have been

modified to arrive at the claimed invention. In our view,

the examiner's analysis is sufficiently reasonable that we

find that the examiner has satisfied the burden of presenting

a prima facie case of obviousness. That is, the examiner's

analysis, if left unrebutted, would be sufficient to support a

rejection under 35 U.S.C. § 103. The burden is, therefore,

upon appellant to come forward with evidence or arguments

which persuasively rebut the examiner's prima facie case of

obviousness. Appellant has presented at least one substantive

argument in response to the examiner's rejection. Therefore,

we consider obviousness based upon the totality of the

evidence and the relative persuasiveness of the arguments.

With respect to claim 7 specifically, the examiner

reads the claim on the disclosure of Obata [answer, pages 3-

4]. The examiner notes that Obata fails to disclose the

scanning means or the recording means, but the examiner

provides an analysis as to why these elements would have been

an obvious modification to Obata. We note that appellant does

not question these particular findings of the examiner. Thus,

we accept the examiner's conclusion that at least the claimed

scanning means and the recording means would have been obvious

to the artisan in view of the teachings of Obata.

The examiner also notes that Obata "fails to

explicitly disclose" the means for "defining a density contour

shape" and "defining a density gradient profile" [answer,

pages 5-6]. Although the examiner's analysis nominally looks

at this question as an obviousness question, the examiner's

analysis also makes it clear that the examiner's position is

that these parameters, in fact, already exist in Obata. Thus,

the examiner finds that the edges of the shapes in Obata

define contour shapes within the meaning of the claim.

Likewise, the examiner finds that the calculation of shadows

of varying intensity in Obata is a determination of density

gradients because a varying density defines a density gradient

profile [answer, page 6]. Therefore, the obviousness issue

with respect to claim 7 actually reduces to a consideration of

whether the Obata device meets the recitations of the density

contour shape and the density gradient profile.

Appellant points to these two parameters and argues

that the examiner admits that these two features are not

disclosed by Obata and that the examiner's reasoning is not

persuasive. Specifically, appellant argues that the claims

call for a data entry means which is used by an operator, and

the resultant data of the claim cannot be met by the edges and

shadows of the original image in Obata [brief, pages 8-9].

The examiner responds that "claim 1 [sic, 7] does not recite

any operator," and whatever manner the data got into the Obata

computer would meet the claimed data entry means [answer, page

9]. We agree with the examiner on this point.

Whatever data has been stored in the Obata computer

which permits objects to be drawn with variable shading meets

the claim recitation of defining a density contour shape and

defining a density gradient profile. Although the density

contour shapes and density gradient profiles of Obata may be

different from what appellant intended in his preferred

embodiment, we agree with the examiner that the broad

recitation of these parameters is met by the variable shading system of Obata.

In summary, appellant's argument with respect to claim 7 is that the differences acknowledged by the examiner between Obata and the claimed invention cannot be obvious over the single Obata reference. As we noted above, however, the examiner's position on this point is that these "differences" are actually present in Obata or are obviously present in Obata. Thus, the question is one of claim interpretation and the scope of the prior art. Giving claim 7 its broadest reasonable interpretation, we agree with the examiner that the processing means of Obata does define a density contour shape and a density gradient profile. Therefore, we sustain the examiner's rejection of claims 7-11.

With respect to claim 12, the examiner finds that the various light sources in Obata modify the shadows, and that this type of modification is a form of noise [answer, page 7]. Appellant responds that there is no suggestion in Obata for "intentionally generating noise data based on a noise factor entered by the operator" [brief, page 10]. The examiner responds that the utilization of ambient light approximates a

random reflection of light which is a type of noise data which

has been entered by the operator. We do not agree.

The concept of noise data in claim 12 is that the

operator specifically chooses a noise factor which is used to

correct the modified image data. Noise by definition affects

processing in a random manner. The examiner's assertion that

the

reflections of light in Obata are random is without

foundation. All light sources in Obata have known locations

and the objects have specific shapes. The reflected light in

Obata is based on theoretical considerations of light

reflection and is not a function of randomness. Therefore, we

do not agree with the examiner that the shadowing in Obata can

be considered to include noise data based on a noise factor

entered by an operator. Since the examiner's conclusion is

not supported by the record in this case, we do not sustain

the rejection of claim 12.

In conclusion, we have sustained the examiner's

rejection of claims 7-11, but we have not sustained the

rejection of claim 12. Therefore, the decision of the

examiner rejecting claims 7-12 is affirmed-in-part.

No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR

§ 1.136(a).

<u>AFFIRMED-IN-PART</u>

Appeal No. 95-4390
Application08/066,273

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                Administrative Patent Judge   )
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) BOARD OF PATENT
                JERRY SMITH   )
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